

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RALPH H. BLAND, JAMES M. JONZA, JAMES D. SMITH,
JEFFREY F. BRADLEY and KENNETH B. SMITH

Appeal No. 95-4535
Application No. 07/955,116¹

ON BRIEF

Before KIMLIN, JOHN D. SMITH and GARRIS, Administrative Patent Judges.

JOHN D. SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal pursuant to 35 U.S.C. § 134 from the final rejection of claims 1-14, 16-19, 22, 24-30, and 32-62. In the examiner's supplemental answer entered June 25, 1997 as Paper

¹ Application for patent filed October 1, 1992.

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No. 21, appealed claims 47-56 were indicated as allowable if rewritten in independent form. After indicating that "all issues" identified in the answer mailed April 13, 1995 "are moot" (page 3 of the supplemental answer), the examiner newly rejected appealed claims 32-46 and appealed claims 1-14, 16-19, 22, 24-30 and 57-61 under "the judicially created doctrine of double patenting" over the respective claims in two newly issued U.S. patents. See the supplemental answer at pages 5 and 6. Appellants responded to these new double patenting rejections in their "Brief in Reply to the Examiner's Supplemental Answer" entered as Paper No. 23 on August 18, 1997. Thus, remaining for our review in this appeal are the new double patenting rejections of claims 1-14, 16-19, 22, 24-30, 32-46 and 57-61.

Representative claims 1 and 32 are reproduced below:

1. A tear resistant film comprising a total of at least three stiff and ductile layers situated one on the randomly in the array wherein (a) at least one layer is a stiff polyester or copolyester that has a tensile modulus greater than 200 kpsi, (b) at least one other layer is a ductile sebacic acid based copolyester that (i) comprises at least 1 mole equivalent of sebacic acid, including ester derivatives thereof, based on 100 mole equivalents of acid components, including ester derivatives thereof, in the copolyester, (ii) has a tensile modulus less than 200 kpsi, (iii) has a tensile elongation greater than 50%, and (iv) provides from about 1

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weight percent to 50 weight percent of the tear resistant film, and (c) the tear resistant film demonstrates a Graves area in one direction of the film which exceeds the Graves area, in the same direction, of a single layer film having a thickness substantially equal to the thickness of the tear resistant film, the single layer film including only the stiff polyester or copolyester of the tear resistant film.

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32. A security control laminate comprising a first tear resistant film according to claim 1 having a first face and a second face opposite the first face and a first layer of adhesive of the first face of the tear resistant film.

The references relied upon by the examiner are:

Bland et al. (Bland'842)	5,427,842	June
27, 1995		
Bland et al. (Bland'019)	5,604,019	
February 18, 1997		

Appealed claims 1-14, 16-19, 22, 24-30, and 57-61 stand rejected "under the judicially created doctrine of double patenting" over claims 1-40 of U. S. Patent No. 5,604,019 (Bland'019) "since the claims, if allowed, would improperly extend 'the right to exclude' already granted in the patent". Appealed claims 32-46 stand rejected on the same basis over claims 1-43 of U. S. Patent No. 5,427,842 (Bland'842).

We cannot sustain the stated rejections.

The examiner's rejections of the appealed claims for double patenting are based on alleged circumstances essentially identical to those before the court in In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968) wherein an applicant later sought patent protection in a voluntary divisional application for an invention (i.e., the best mode) fully disclosed in and covered by broad claims in an earlier

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issued patent. Since there was no reason preventing the applicant from presenting the claims to the best mode for examination in the application of the issued patent (and no terminal disclaimer had been filed), the Schneller court held that the rule against "double patenting" must be applied to avoid the "timewise extension of the protection afforded" by Schneller's earlier patent.

With regard to the claims issued in Bland'019 and Bland'842 which are directed to a tear resistant film and a security control laminate comprised of a tear resistant film respectively, the examiner points out that such patented claims define the ductile layer component of the tear resistant film broadly, although each patent allegedly discloses that such ductile layer may be composed of a ductile copolyester comprising a sebacic acid component, while the appealed claims require a ductile layer component of a tear resistant film as "a ductile sebacic acid based copolyester that (i) comprises at least 1 mole equivalent of sebacic acid, based on 100 mole equivalents of acid components." Thus, the examiner argues that like the situation in Schneller, the subject matter claimed in the instant application is fully

disclosed in the respectively applied patents and is covered by the broad claims in the issued patents.

Appellants point out in their "brief in reply" that none of the claims in either Bland'019 or Bland'842 fully cover the subject matter of the appealed claims which require a tear resistant film or tear resistant film component to include at least three stiff and ductile layers while the patented claims require the same tear resistant film component as including more than five stiff and ductile layers.

Thus, as argued by appellants, the factual situation in this appeal differs significantly from the circumstances present in Schneller. While the herein appealed claims and patented claims may cover overlapping subject matter² in terms of the number of layers required, the patented claims do not

² The examiner should revisit the question of whether an obviousness-type double patenting rejection is applicable under the circumstances presented here. In this regard, the examiner may wish to review the genus-species guidelines (MPEP § 2144.08 July 1998) concerning the issue regarding the herein claimed ductile sebacic acid based copolyester ductile film component which is covered by patented claims to ductile film copolyester component. See, for example, claim 14 of Bland'019.

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fully cover³ the subject matter in the same way that the broad
claims issued to

³ We find no disclosures in the Bland patents of tear resistant films having only three layers. Thus, is there is apparently no basis to support the examiner's contention that the subject matter claimed in the instant application is fully disclosed in the patents.

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Schneller covered Schneller's best mode presented in a later
filed voluntary divisional application. Accordingly, the
examiner's rejections cannot be sustained.

REVERSED

The decision of the examiner is reversed.

EDWARD C. KIMLIN)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
JOHN D. SMITH)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
)	
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)	
BRADLEY R. GARRIS)	
Administrative Patent Judge)	

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Steven E. Skolnick
3M Office of Intellectual Prop. Counsel
P.O. Box 33427
St. Paul, MN 55133-3427

JENINE GILLIS

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Serial No. 07/955,116

Judge JOHN SMITH

Judge KIMLIN

Judge GARRIS

Received: 8/23/99

Typed: 8/23/99

DECISION: REVERSED

Send Reference(s): Yes No
or Translation(s)

Panel Change: Yes No

3-Person Conf. Yes No

Remanded: Yes No

Brief or Heard

Group Art Unit: 1700

Index Sheet-2901 Rejection(s):

Acts 2: _____

Palm: _____

Mailed:

Updated Monthly Disk (FOIA): _____

Updated Monthly Report: _____